

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: GROLLITSCH, Helmut, et al

SERIAL NO.: 10/672,402

ART UNIT: 3653

FILED: September 29, 2003

EXAMINER: Hageman, M.

TITLE: METHOD AND APPARATUS FOR DETECTING A CRACKED OR BROKEN CASE

Amendment D: REMARKS

Upon entry of the present amendments, Claims 39-42 and 44-51 remain in this case. Claim 46 has been amended, and Claim 43 has been canceled. Applicant respectfully requests that the Appeal be withdrawn for consideration of the present amendment with the Request for Continued Examination of the proper set of claims. Applicant respectfully requests the Examiner to consider these amendments and remarks in response the Final Rejection of April 4, 2007.

The present amendments were previously presented under 37 C.F.R. § 1.116 and 37 C.F.R. § 41.33. Specifically, the claims are being presented under 37 C.F.R. § 1.116(b)(2) so as to place the claims into a better condition for appeal and to proper incorporate dependent claims into an independent claim. These amendments were not entered.

The Examiner sent an Advisory Action, indicating that the Appeal Brief was fatally defective for being directed to non-entered claims. The present amendment and Request for Continued Examination are being presented to cure this defect.

There was a typographical error in Claim 46, such that the proper incorporation of Claim 32 and 37 was not realized in Claim 46. The orientation limitation was not included properly in Claim 46, even though the Applicant explicitly referred to the incorporation of all limitations in allowable form in the previous amendment. As such, the original allowable subject matter may have been

inadvertently omitted from Claim 46. The form of Claim 46 requires correction to be considered properly. Furthermore, no new subject matter has been added, and no new search is required by the insertion of this language. The subject matter added is the subject matter of original Claim 21.

Claim 43 has been canceled. Applicant has canceled this third issue for consideration, reducing the number of issues with respect to the Final Action of April 4, 2007 and removing the issue from possible appeal.

With regard to the patentability of the currently presented claims, Claim 46 includes the subject matter of original Claims 13, 17, 19 and 21 and the additional step of ejecting. The step of ejecting was recited in order to avoid an obviousness rejection based upon the European Patent No. 0043170 (the '170 patent) and the Huang patent in a previous Office Action. The original subject matter of Claims 13, 17, and 21 were previously determined to be allowable subject matter over the '170 patent in two previous Office Actions. Applicant respectfully contends that Claims 46-51 of the present invention are still patentable over the '170 patent. Furthermore, Claims 46-51 include further limitations that further distinguish the present invention from the single '170 patent.

A typographical error occurred between the preparation of Claim 46 from Claims 32 and 37 in the amendment of January 15, 2007. The originally allowed subject matter of Claim 21 was inadvertently omitted from Claim 46. Applicant has now concurrently amended Claim 46 such that the proper limitations are now contained in the current version of Claim 46. No new subject matter has been added by these amendments because the subject matter was originally presented as Claim 21. Applicant maintained the intention to incorporate all suggested claims from the very beginning of the prosecution on the merits.

As such, Applicant respectfully contends that Claims 46-51 are no longer anticipated by the

'170 patent. The additional ejection step and the orientation limitation are not disclosed by this prior art reference. These limitations are now properly recited in the current Claim 46. These claims should be allowed as previously indicated throughout the prosecution of the application.

Alternative to a Final Rejection, Applicant is willing to consider any alternative claim language proposed or suggested by the Examiner.

On this basis, Applicant respectfully contends that Claims 39-42 and 44-51 are now in a proper condition for consideration. Applicant respectfully requests reconsideration of the claim language for allowance.

Respectfully submitted,

<u>December 7, 2007</u>	<u>/Andrew W. Chu/</u>
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